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REMARKS

Applicants note that, in the instant Office action, the Office has corrected the restriction requirement mailed March 8, 2004. As corrected, the Office asserts that claims 1-5 are withdrawn from consideration. However, Applicants respectfully assert that this restriction is an error. Claims 12-13 are dependent on the method of claim 1. As such, claims 6-11, drawn to the wet wipe, are elected for examination and claims 1-5 and 12-13 are withdrawn from consideration as being drawn to a non-elected invention.

Claims 6 and 9-11 have been amended herein in this Amendment B to require the Yucca species extract of the invention to be a *Yucca schidigera* extract. Support for these amendments can be found in original dependent claim 12 and throughout the instant specification, specifically, on page 2, lines 7-14, page 4, lines 24-29, and page 5, lines 17-22. Claims 6-11 are pending in this case. No new matter has been added by these amendments. Applicants respectfully request reconsideration and allowance of all pending claims.

1. Rejection of Claims 6-11 Under 35 U.S.C. §112

Reconsideration is requested of the rejection of claims 6-11 under 35 U.S.C. §112 as containing a trademark/trade name to identify or describe a particular material or product.

Claims 6-11 have been amended to replace the trademark/trade name "Yucca 70" with "Yucca schidigera extract". As such, the rejection to the use of the trademark "Yucca 70" should be withdrawn as moot. No new matter has been added to the application by this amendment.

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2. Rejection of Claims 6-11 Under 35 U.S.C. §102(b) or §103(a)

Reconsideration is requested of the rejection of claims 6-11 under 35 U.S.C. §102(b) as being anticipated by Znaiden et al. (6,159,487), or in the alternative under 35 U.S.C. §103(a) as obvious over Znaiden et al.

Claim 6, as herein amended, is directed to a wet wipe for controlling the production of ammonia by urine. The wet wipe comprises a flexible sheet material and a composition held by the sheet, wherein the composition comprises a Yucca schidigera extract.

Znaiden et al. disclose a cosmetic product for soothing, reducing puffiness, and lessening dark circles around the eyes. The cosmetic product includes a container; an absorbent pad, made from natural or synthetic fibers, with printing on at least one major surface; and a fluid cosmetic composition within the container and at least partially absorbed onto the absorbent pad. The fluid cosmetic composition contains primarily water; but can also contain polyhydric alcohols, emulsifiers, preservatives, and natural botanical ingredients. The amount of optional natural botanical ingredients may be 0.00001 to 10% by weight, and the disclosed natural botanicals include plant purees, extracts, and vitamins. A laundry list of about 125 sources from which extracts and other derivatives can be obtained is disclosed. One of the generic sources disclosed is Yucca.

Significantly, Znaiden et al. fail to disclose a wet wipe for controlling the production of ammonia by urine comprising a composition comprising a Yucca schidigera extract. This is a requirement of claim 6, and is a significant aspect of Applicants' invention. Although the reference discloses the

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Yucca species generally in a long list of about 125 sources, there is no disclosure of the specific Yucca species, *Yucca schidigera*, as required by amended claim 6. Additionally, and importantly, none of the six or so working Examples of Znaiden et al. disclose the use of any Yucca species extract for soothing, reducing puffiness, and lessening dark circles around the eyes, or otherwise.

M.P.E.P. §2131 states that a claim is anticipated under 35 U.S.C. §102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

As previously indicated, Znaiden et al. disclose Yucca extract generally in an eye pad, but do not specifically list *Yucca schidigera* as a suitable Yucca species extract that may be used for soothing, reducing puffiness, and lessening dark circles around the eye. Specifically, Znaiden et al. fail to list any suitable Yucca extract. As such, Znaiden et al. fail to disclose each and every element of claim 6, and thus, claim 6 cannot be anticipated by the Znaiden et al. reference.

Turning now to the obviousness rejection of claims 6-11 based on Znaiden et al., the Office claims that it is obvious to one with ordinary skill in the art at the time the invention was made to provide the wipe of Znaiden et al. with the well-known Yucca 70™ from Sher-Mar Enterprises since such is a mere selection of a known material on the basis of suitability for the intended use.

In order for the office to show a *prima facie* case of obviousness, M.P.E.P §2143 requires that the Office must meet three criteria: (1) the prior art reference must teach or suggest all of the claim limitations; (2) there must be some suggestion

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or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and (3) there must be some reasonable expectation of success. The Office has clearly failed to meet its burden under number (1) and/or (2) above, as the Znaiden et al. reference has not taught or suggested all of the claimed limitations and there is no motivation or suggestion to modify the Znaiden et al. reference to arrive at each and every limitation of Applicants' invention.

As noted above, Znaiden et al. do not teach or suggest a wet wipe comprising a composition comprising a *Yucca schidigera* extract. Additionally, there is no motivation or suggestion to modify the Znaiden et al. reference to arrive at Applicants' invention. As stated above, Znaiden et al. generally disclose Yucca in a long laundry list of 125 optional compounds to be used in its cosmetic composition for reducing puffiness, soothing, and lessening dark circles around the eye.¹ As such, in order to arrive at Applicants' claim 6, one skilled in the art must choose Yucca from the myriad of options in Znaiden et al. Furthermore, one skilled in the art must choose the specific Yucca species, *Yucca schidigera*, for use in its product. These choices would have had to be made without any teaching or suggestion by the cited reference. With all due respect, it appears that the Office has used improper hindsight analysis and reconstruction to modify the Znaiden et al. reference. The Federal Circuit has repeatedly cautioned against hindsight analysis and held that

¹A laundry list disclosure will not reasonably lead one skilled in the art to any particular species. See *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571 (Fed. Cir., 1996).

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such practice is improper.² As such, one skilled in the art and looking at the Znaiden et al. reference would not, and could not, be motivated to modify the Znaiden et al. reference to arrive at each and every element of the instant claim 6. Thus, claim 6 cannot be said to be obvious in view of the cited reference.

Claims 7-11 directly or indirectly depend from claim 6. Therefore these claims are patentable for the same reasons as amended claim 6 set forth above, as well as for the additional elements they require.

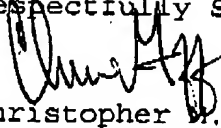
Conclusion

In view of the above, Applicants respectfully request favorable reconsideration and allowance of all pending claims. The Commissioner is hereby authorized to charge any fee deficiency in connection with this Amendment B to Deposit Account Number 19-1345 in the name of Senniger, Powers, Leavitt & Roedel.

²Grain Processing Corp. v. American-Maize-Products, Co., 840 F.2d 902, 904 (Fed. Cir. 1988). M.P.E.P. §2142 provides that in order to reach a proper determination under 35 U.S.C. §103(a), the Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. Knowledge of Applicants' disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences." The tendency to resort to "hindsight" based upon Applicants' disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

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Respectfully Submitted,


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